

PRIOR ART REJECTION

Claims 1, 5-7, 9, 11-13, 20, 25 and 26 were rejected under 35 U.S.C. § 103 as being obvious over Salzman in view of the newly cited U.S. patent 4,723,364 (Marxer). No other rejections were applied against the claims.

Claim 1 recites in part a sport shoe comprising an upper and a sole surmounted by the upper and comprising at least three layers external to the upper, the layers including an upper comfort layer having elastic shock absorbing properties. Thus the claimed “upper comfort layer” is a part of a sole “surmounted by” the upper.

The examiner is entitled to give the claim terms their broadest reasonable interpretation, i.e., their plain meaning as understood by those skilled in the art. MPEP § 2111.01. The ordinary meaning of “surmount” is to “stand or lie at the top of.” *Merriam Webster’s Collegiate Dictionary*, 10<sup>th</sup> Ed. Salzman does not teach or suggest a sport shoe comprising an upper and a sole including a comfort layer having elastic shock absorbing properties, wherein the upper “surmounts,” i.e., lies on top of, a comfort layer of the sole.

The Office Action considers the liner 50 of the ski boot of Salzman to correspond to the claimed comfort layer of the sole. However *the liner 50 of Salzman is a part of the upper itself and not a part of the sole*. The liner 50 is secured “over the inner surface of the sole section and upper section” (col. 3, lines 55-58). The liner 50 is consequently situated *inside* the upper section 12 of the ski boot and is not part of the sole. Additionally, the liner 50, being inside of the upper, is not “surmounted by” the upper. Thus the liner 50 of Salzman cannot comprise the claimed comfort layer of a sole, surmounted by the upper, of a sport shoe.

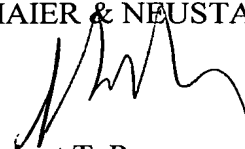
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In any case, there is no evidence that the liner 50 of Salzman has elastic shock absorbing properties. The Office Action has therefore relied on Marxer to suggest providing a sole including a comfort layer having elastic shock absorbing properties in Salzman. However the synthetic foam material of Marxer suffers from the same shortcoming as does the liner 50 of Salzman: it is part of the upper and not a layer of a sole surmounted by the upper. The foam material in Marxer comprises a foot shaped shell and so is inherently designed to fit within the upper. Since it fits within the upper, the liner is not "surmounted by" the upper and so would not provide one skilled in the art with a suggestion for modifying the sole in Salzman. Accordingly, Claim 1 and its dependent claims define over any combination of these references.

Applicants therefore believe that the present application is in a condition for allowance and respectfully solicit an early notice of allowability.

Respectfully submitted,

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